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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,195	02/19/2002	Michael Paul Bouchette	6497	6854

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/078,195	BOUCHETTE ET AL.	
	Examiner	Art Unit	
	Jenna-Leigh Befumo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5 and 8-14 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6 and 7 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Amendment submitted on January 7, 2004, has been entered. Claims 1, 5, 6, 8, 10, 12, and 13 have been amended. Therefore, the pending claims are 1 – 14. Claims 11 – 13 are withdrawn from consideration as being drawn to a nonelected invention.
2. The amendment to the specification is sufficient to overcome the objection to the drawings and the objection to the specification set forth in section 4 and 5 and section 6 of the previous Office Action, respectively.
3. The objection to the claims set forth in section 7 of the previous Office Action is withdrawn due to the removal of the phrase “as per the method described in Example 1” from claims 1, 6, 8, and 10.
4. The 35 USC 112 2nd paragraph rejections are withdrawn since the Applicant has amended the claims to correct the antecedent basis problems set forth in the previous Office Action.
5. The 35 USC 102/103 rejection to claims 1 – 4 based on DeProspero et al. (5,639,539) is withdrawn since the Applicant has provided evidence to show that the adhesive composite taught by DeProspero et al. would not have the claimed adhesion value. Nor would it be obvious to modify the adhesion value of the composite fabric taught by DeProspero et al., since the fabric is used as wallpaper, so one of ordinary skill would not lower the adhesion value of the adhesive layer since it would be too easy to remove the wallpaper from the wall surface.

Claim Rejections - 35 USC § 102/103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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7. Claims 1 – 3 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kesti et al. (5,824,748) for the reasons of record.

8. Claims 1 – 3 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Delgado et al. (5,908,693) for the reasons of record.

Claim Rejections - 35 USC § 103

9. Claims 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Delgado et al. in view of McKnight (4,561,435) for the reasons of record.

Allowable Subject Matter

10. Claims 5 and 8 – 14 are allowed.

11. Claims 8 – 10 are generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 11 – 13, directed to the species of a nonwoven laminate having a batting layer as the additional layer is no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicants are advised that if any claims depending from or including all the limitations of the allowable generic linking claims be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is

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withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

12. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's arguments filed January 7, 2004 have been fully considered but they are not persuasive. The Applicant argues that Kesti et al. does not anticipate or make obvious the claimed invention because Kesti et al. is directed to microspheres comprising two polymers and not microcapsules (Response, page 7). It is unclear how the microsphere taught by Kesti et al. is outside the scope of the microcapsule limitation recited in claim 1. The claim only requires that the microcapsule contains adhesive. The Applicant does not recite limitations directed to the material that the microsphere is made from or how the adhesive is contained in the microcapsule. Therefore, the small round microspheres taught by Kesti et al. are not excluded by the Applicant's claim and read on the recited microcapsule. Thus, the rejection is maintained.

Further, the Applicant argues that Kesti et al. fails to focus on a non-slip resistance or appreciate that the microspheres might have the recited properties or could be used as a non slip coating (Response, page 7). However, it has been held that that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999). Hence, as long as the property is inherent to the prior art it does not need to be

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recognized or appreciated by the prior art to anticipate or render obvious the claimed product. Therefore, Kesti et al. does not need to teach a non slip article. Additionally, it is noted that the applicant has the burden of showing that the claimed properties are not inherent in the prior art. *In re Spada*, 911 F.2d 705, 508, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Further, the arguments that Kesti et al. examples have adhesion with static shear values in excess of 17,000 is not sufficient since this property is not related to the claimed properties. Without knowing what drag values and adhesion values would be produced with a static shear value of 17,000 the Examiner is unable to determine whether or not Kesti et al. would have the claimed properties. Applicant's arguments cannot take the place of evidence. *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965).

Finally, the Applicant argues that Kesti et al. uses examples where the adhesive is coated onto paper or film layers. However, in the disclosure Kesti et al. discloses that nonwoven fabrics can be used as the backing layer for the adhesive article. Thus, Kesti et al. discloses that the adhesive can be applied to a nonwoven layer. Kesti et al. is not limited to its examples. See *In re Fracalossi*, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982). Therefore, the rejection based on Kesti et al. is maintained.

With respect to the rejection based on Delgado et al. the applicant argues that Delgado fails to teach a nonslip nonwoven fabric, a nonslip table covering, or a nonslip disposable footwear. First, as set forth above, the prior art does not need to appreciate a property to anticipate or render obvious a claimed product. Therefore, Delgado does not need to state that the fabric is a nonslip fabric if it inherently has that function, whether or not it is recognized in the prior art. Second, the intended use of the nonslip fabric as a table cloth or footwear does not

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add structural limitations to the claimed product. As set forth in the previous Office action, it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Thus, until the claims recite specific structural features of the table covering or the footwear (as is done in claim 8) than these limitations are not given any patentable weight. Therefore, the rejection is maintained.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

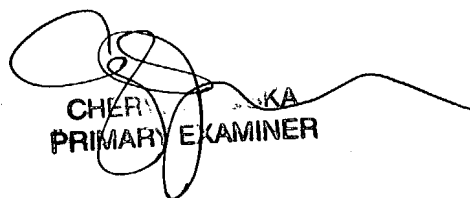
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jenna-Leigh Befumo
February 12, 2004



CHERYL KA
PRIMARY EXAMINER